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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,998	10/16/2003	Patrick J. Sweeney	029815-0103	7428

26371 7590 09/09/2005  
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EXAMINER

BARRETT, THOMAS C

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/686,998

Applicant(s)

SWEENEY, PATRICK J.

Examiner

Thomas C. Barrett

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) 10, 12, 18, 19, 22, 28, 37, 43-60, 66 and 70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 13-17, 20, 21, 23-27, 29-36, 38-42, 61-65 and 67-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8-05, 6-05, 8-04, 1-04</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of Invention I, Species I, Subspecies (i) in the reply filed on June 16 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 18, 28, 37, 43-60 and 66 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, species or subspecies, there being no allowable generic or linking claim. In addition, the Examiner has withdrawn claims 10, 12, 19, 22 and 70 as being drawn to a nonelected subspecies (e.g. one without teeth) or as being dependent on a withdrawn claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

And

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Berry et al. (2005/0060034). Berry et al. discloses a spinal implant system, comprising:

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a vertebral prosthesis, endplates and artificial spinal discs (e.g. Fig. 9B) interlocked to a flange on the endplate to prevent rotation of the disc relative to the plate.

Claims 1-3, 5-6, and 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Main et al. (4,932,975) as cited in Applicant's IDS. Main et al. discloses a spinal implant system, comprising: a vertebral prosthesis having an adjustable support (e.g. 32) and an endplate (e.g. 20') threaded to it, and an artificial spinal disc (e.g. 11') interlocked to a flange (Fig. 10) on the endplate to prevent rotation of the disc relative to the plate (Fig. 14).

Claims 11, 13-17, 20-21, 23-27, 29-36, 38-42, and 61-62 rejected under 35 U.S.C. 102(b) as being anticipated by Rabbe et al. (5,702,453) as cited in Applicant's IDS. Rabbe et al. discloses a spinal implant system, comprising: a vertebral prosthesis having a support and an endplate, wherein the support is adjustable to change the height of the vertebral prosthesis (Fig. 3); and a pedicle screw (e.g. 5). Please note that any screw can act as a pedicle screw, and that the disc prostheses of claims 11, 13-17, 20-21, 23-27, 29-36, 38-42 are not positively recited.

Claims 61-65 are rejected under 35 U.S.C. 102(b) as being anticipated by Strnad et al. (5,702,453) as cited in Applicant's IDS. Strnad et al. discloses a spinal implant system (Figs. 8a-9), comprising: a vertebral prosthesis having a support and an endplate, wherein the support is adjustable by sliding and uses a locking ring (110), a pedicle screw and retainer (202). Please note that any screw can act as a pedicle screw.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 61 and 67-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry et al. (2005/0060034). Berry et al. discloses, "Referring to FIG. 12c, in one embodiment, either of the socket and ball components 400, 402 can be secured to an adjacent vertebral bone, such as an arch 422, via a linkage 424" (paragraph 0085). However Berry et al. fails to disclose specifically that the linkage can be a pedicle screw. It is well known to ones of ordinary skill in the art to use screws as linkages for ease of insertion and strength. It would have been obvious to one of ordinary skill in the art to combine the teaching of a screw, e.g. a pedicle screw to the system of Berry et al, the motivation to combine being that the use of screws for linkages is well known for fastening strength and ease of use.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas C. Barrett whose telephone number is (571) 272-4746. The examiner can normally be reached Tuesday-Friday between 9:00 A.M. and 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Thomas Barrett', with a stylized flourish at the end.

Thomas Barrett  
Examiner  
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